

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/955,594 Confirmation No.: 1177
Applicant: Philip M. Ginsberg
Title: SYSTEMS AND METHODS FOR SHARING EXCESS PROFITS
Filed: September 5, 2001
Art Unit: 3694
Examiner: Daniel L. Greene

Atty. Docket: CF/047 – 01-1047
Customer No. 63710

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CORRECTION OF OFFICE ACTION PURSUANT TO MPEP § 710.06

Pursuant to MPEP § 710.06, Applicant calls to the attention of the Office errors in the Office Action of August 15, 2007 and respectfully requests (a) that the Office reissue the Office Action in corrected and completed form, and (b) reset the period for reply to one month from the date of the reissued Office Action.

I. Election Requirement

When an Office Action states reasons for a requirement that do not align with the reasons authorized in the MPEP, the MPEP controls, and the Office Action is either void, or at most effective only to the extent authorized by the MPEP. The Office Action fails to comply with the MPEP regarding the purported election requirement at least for the following reasons:

1. The August 15, 2007 Office Action asserts there is a “serious search burden.” MPEP § 803(I)(B), § 803(II) ¶ 4, and § 806.01 requires “Examiners must provide reasons and/or examples to support conclusions” of “unduly extensive and burdensome search,” for example, by “appropriate explanation of separate classification, or separate status in the art, or a different field of search.” The statements in the August 15 Office Action and prior Office Actions do not provide appropriate explanations to the grounds stated in MPEP § 803(II) ¶ 4. Applicant is unable to reply until the Office Action has stated “reasons and/or examples to support conclusions” that relate to relevant criteria. How do

the various dependent claims that the Office Action refers to as separate species require different search queries or otherwise produce an unduly extensive and burdensome search? Applicants can not reply without such evidence presented.

2. MPEP § 808.02 states that “where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.” Accordingly, since there has been no evidence presented that there is a required different field of search, and all of the claims fall within art class 705 and subclass 037, no election requirement can exist in accordance with the MPEP.

3. A requirement under 37 C.F.R. § 1.146 permits an applicant to elect a “reasonable” number of species. What is a “reasonable” number, in view of the filing fees paid, and what published document articulates a standard?¹ The Board has held that Applicants are free to decide on a number of claims as long as the fees for those claims are paid.

4. MPEP § 806.04(f) permits a requirement to elect only “if the species are mutually exclusive.” The January 2007 Office paper conceded in ¶ 5 that the claims do overlap in scope. How does § 806.04(f) apply in such a situation? If the Examiner believes that election among *non-mutually-exclusive* “inventions” of overlapping scope is authorized by the MPEP, Applicant requests identification of the particular MPEP section that overrides § 806.04(f).

Departure from the MPEP will lead to confusion, frustration at lack of clearly communicated expectations, and delay. Applicant respectfully urges that the MPEP provides a set of principles that Applicants and Examiner can expect of each other. If expectations are shared, prosecution will proceed much more efficiently. If there is some basis for requiring election and referring to matter as new matter that complies with all requirements stated in all MPEP and 37 C.F.R. sections noted above, Applicants requests a clear and internally-consistent statement. Since the election requirement is lacking at least for the reasons above, no requirement even exists. The undersigned attorney is under an ethical obligation not to surrender patent rights until the Office has made a *bona fide* showing under established written procedures that the rights sought exceed those provided by law.

¹ See *Ex parte Maloney*, 1999 WL 33205694 at *2, www.uspto.gov/go/dcom/bpai/decisions/fd983299.pdf at pp. 4-5 (Bd. Pat. App & Interf. May 24, 1999) (“it is well established that an applicant has the choice of deciding as to the number of claims so long as they are consistent with the disclosure and the requisite filing fees are paid.”).

II. Withdrawn Claims and Finality of Requirement

Paragraph 5 of the Office Action purports to withdraw claims 8, 11, 12, 21, and 30 from consideration. Since no Office Action (i.e., the present action or previous actions) includes a restriction or election requirement that is complete and consistent with the MPEP, no restriction or election requirement exists, and no claims may be unilaterally withdrawn by the Office. Applicants respectfully request an Office Action that conforms to these standards and acknowledges that claims 8, 11, 12, 21, and 30 are not withdrawn.

Further, a non-existent requirement cannot be made final. Applicants note that the Action of January 2007 was withdrawn pursuant to MPEP § 710.06 by the paper of May 18, 2007. There is therefore no first statement of any election requirement that could mature into a “final” requirement. Applicants respectfully request a corrected Office Action that does not purport to make any election requirement final since no prior election requirement during the prosecution of this application has been valid.

III. No New Matter

Paragraph (g) of the August 15, 2007 Office Action appears to raise a “new matter” issue. The new matter issue raised does not conform to any known new matter standard allowed under the MPEP or any other source of law. Under what statute or rule is material that was not amended into the specification or the claims “new matter?” Unless there is some recognizable principle of law invoked, Applicants cannot reply. Accordingly, under MPEP 710.06 Applicants request that this error be corrected so that a complete response to the Office Action can be provided, and that a new period of reply be set for response to the corrected Office Action.

IV. Claim Rejections – 35 U.S.C. § 101

The Office Action includes a purported rejection of claims 25-32 under § 101 as allegedly being drawn to non-statutory subject matter. MPEP § 2106 provides instructions on § 101. The Office Action bears no relationship to the analysis required by the MPEP. The Examiner’s attention is drawn to the following chart from MPEP § 2106:

**DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH THE SUBJECT
MATTER ELIGIBILITY REQUIREMENT OF 35 U.S.C. 101**

- Does the Claimed Invention Fall Within an Enumerated Statutory Category?
- Does the Claimed Invention Fall With a 35 U.S.C. 101 Judicial Exception – Law of Nature, Natural Phenomena or Abstract Idea?
- Does the Claimed Invention Cover a 35 U.S.C. 101 Judicial Exception, or a Practical Application of a 35 U.S.C. 101 Judicial Exception?
 - Practical Application by Physical Transformation?
 - Practical Application That Produces a Useful (35 U.S.C. 35 U.S.C. 101 utility), Tangible, and Concrete Result?
- Does the Claimed Invention Preempt a 35 U.S.C. 101 Judicial Exception (Abstract Idea, Law of Nature, or Natural Phenomenon)?
- Establish on the Record a Prima Facie Case

In the alleged § 101 rejections, there is no identification of any “law of nature, natural phenomenon, or abstract idea.” There is no discussion of “practical application.” No rejection is stated under any recognizable legal standard. Applicants therefore, respectfully request a corrected Office Action conforming to MPEP § 2106.

V. Conclusion

Applicant requests a corrected Office Action, and if no such Action can be prepared, that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. CF/047 – 01-1047.

Respectfully submitted,

Dated: September 21, 2007

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